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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,783	05/18/2006	Prahalad Manibhai Mistry	066079-5131	3975

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EXAMINER

VALENROD, YEVGENY

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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02/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/579,783	Applicant(s) MISTRY ET AL.	
	Examiner YEVEGENY VALENROD	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a non-final office action in application # 10/579,783. This application has been transferred to Examiner Valenrod, Art Unit 1621, whose contact information is provided at the end of the instant document.

Amendment to the claims filed 2/5/09 is acknowledged.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-9 (and newly added claim 15), in the reply filed on 2/5/09 is acknowledged. The traversal is on the ground(s) that WO 03/095562 is not proper art. This is not found persuasive because although applicant is correct concerning applicability of WO 03/095562 as art, the unity of invention is still broken by US 3,207,746 where applicants' claimed compound is disclosed (see rejection below).

The requirement is still deemed proper and is therefore made FINAL.

Claims 10-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/5/09.

Claim Objections

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Claim 7 is objected to because of the following informalities: Claim 7 comprises a limitation directing to a figure in specification. Where possible, the content of figures are to be included in the claim language. In the instant case, the structures found in the specification can be listed in claim 7. Appropriate correction is required.

Claim Rejections - 35 USC § 102

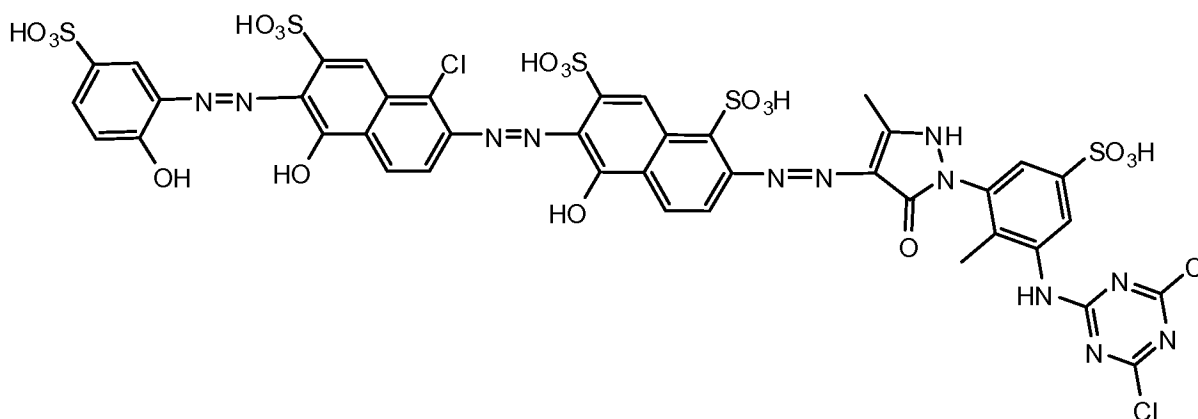
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102 (b) as being anticipated by Andrew et al. (US 3,207,746).

Andrew discloses preparation of the following compound in example 94 (column 15)



The above compound meets all the structural limitations found in claims 1-3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaeda et al. (JP 01135880 STN Abstract).

Scope of prior art

Sakaeda et al. disclose compound of formula (I) and a composition of the compound of formula (I) in water and diethylene glycol. Sakaeda et al. also describe the composition being used for production of prints.

Ascertaining the difference

The compound of formula (I) differs from the instantly claimed compound in the position on the naphthalene of heterocycle carrying diazo group. Also, Sakaeda et al do not teach additional colorant in the composition (limitation of the instant claim 10).

Obviousness

Compound of formula (I) in the reference is a ring isomer of the instantly claimed compound. "Compounds which differ only in the placement of substituents in a ring are not patentable absent unexpected results". In re Jones, 162 F.2d 638, 74 USPQ 152 (CCPA 1947). Compounds that differ in ring position are expected to have similar physical and chemical properties and one skilled in the art would find them to be obvious variants, absent unexpected results. One skilled in the art would suspect that ring isomers of compound I, would be useful in making prints.

One skilled in the art would also find it obvious to add known ingredients (such as known colorants) to a composition designed for printing. Expected result would be colored ink.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,041,161 ('161). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the patented claims overlaps the instantly claimed compound and composition.

Scope of '161

Claims 1-6 of '161 disclose generic compounds and composition comprising the same substitutions as the instantly claimed compounds.

Ascertaining the difference

Claims 1-6 of '161 fail to disclose the correct substitution on the naphthalene ring. The compounds disclosed in '161 are ring isomers of the instant compounds.

Obviousness

Compounds of claims 1-6 of '161 are a ring isomers of the instantly claimed compounds. "Compounds which differ only in the placement of substituents in a ring are not patentable absent unexpected results". In re Jones, 162 F.2d 638, 74 USPQ 152 (CCPA 1947). Compounds that differ in ring position are expected to have similar physical and chemical properties and one skilled in the art would find them to be obvious variants, absent unexpected results. One skilled in the art would suspect that ring isomers of compound I, would be useful in making prints.

Claims 1-9 and 15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-4 and 12-13 of copending Application No. 12/224,616 ('616). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Scope of claims of '616

Claims of '616 are directed to compounds and compositions that are within the scope of the instantly claimed compounds and compositions.

Difference between '616 and instant claims

Claims of '616 fail to disclose specie that would be anticipatory to the instant claims.

Obviousness

One skilled in the arts would find it obvious to prepare compounds and compositions included in the generic structures found in '616. The compounds and compositions are taught with sufficient specificity to render the instantly calmed compounds and compositions obvious. There is significant overlap between the generic structures in '616 and instant claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Claims 1-15 are pending

Claims 10-14 are withdrawn

Claims 1-9 and 15 are rejected

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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